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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,469	02/12/2001	Amiad Solomon	P-2967-US	6390

7590

08/22/2006

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
3693	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/780,469	SOLOMON, AMIAD	
	Examiner	Art Unit	
	JAGDISH PATEL	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 5/23/06.

Response to Amendment

2. Claim 4 has been amended. Claims 1-3 have been cancelled.

Response to Arguments

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejections.

35 U.S.C. §101 Rejection

4. 35 U.S.C. §101 reads:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”

Claims 4-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link,

http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html) for details), a claimed invention as a whole must be useful and

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accomplish a practical application. The applicant is in the best position to explain why an invention is believed useful. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. MPEP 2107 provides details for the analysis of utility, but can be summarized in that practical application must be specific, substantial and credible.

To determine whether the claimed invention satisfies the “practical application” requirement, the claimed invention must produce a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

Claim 4, does not produce a useful, concrete and tangible result because it does not produce a concrete result and therefore a useful result. The interpretation of the claimed invention being concrete is that it must have a result that “can be substantially repeatable or the process must substantially produce the same result again.”(Concrete is antonym of unrepeatable or unpredictable.). The claimed invention therefore lacks practical application and therefore rejected under 35 U.S.C.101.

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Claim 4 raises another issue of indefiniteness because the matching step is broadly interpreted as a manual process. Since, the manually matching want ads and sell ads is a subjective process involving human judgment, therefore, one cannot assure that the matching the want ads and the sell ads would yield the same result, i.e. the same buyer would be notified for a given want ads and sell ads. On the other hand a computerized matching process based upon a set of predefined rules employed in a algorithm would yield same selection of a buyer when a given sets of want ads and sell ads retrieved from the sites searched.

Dependent claims are also rejected for the same reasons.

35 U.S.C. 112 Rejections

5. The following is a quotation of the first paragraph of **35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4-6 are rejected under **35 U.S.C. 112**, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The amended claims recite limitation “without prior interaction of either a buyer or a seller” is not supported by the original disclosure. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

The specification on p. 7 teaches only “The alert module notifies the buyer who placed a want ad that matching sell ads have been found and invite the buyer to access the system (step 256).” However, the specification does not teach how notifying is carried out without any prior interaction of either a buyer or a seller.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 4 is discussed.

9. Claim 4 recites limitation “without prior interaction of either a buyer or a seller” is vague and unclear because without some kind of prior interaction of the seller or the buyer, such as registering with the service provider (“the computer”) whereby some form of contact information for notification is provided, the notification cannot be provided.

Furthermore the term “without prior interaction of either a buyer or a seller”, broadly interpreted precludes any action by the buyer or the seller such as posting ads and providing contact information. It is not conceivable that a buyer who placed advertisement can be notified without the buyer providing his contact information (such

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as e-mail address, postal address, phone number etc.), which is deemed prior interaction of the buyer.

Claim 4 also recites limitation “matching at least one of said want ads with at least one of sell ads”. In this limitation, there is no antecedent basis for “said want ads” and “said sell ads” because the searching sites on the network cannot assure that one or more sell ads corresponding to the wanted good can be found. The result of the searching steps is that at least one want ad for a wanted good or service is found and at least one sell ad for a good or service is found. However, the claim fails to recite such a process step.

Claim 4 recites, “notifying the associated buyer who placed said want ad” without specifying any process step that would specify or extract the contact information of the buyer. Like wise the associated seller cannot be notified without the seller’s contact information.

Claims 5 and 6 are also rejected for the same reasons.

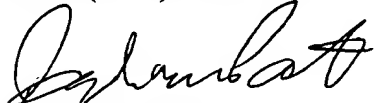
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jagdish N. Patel

(Primary Examiner, AU 3624)

8/7/06